

Remarks

Applicants acknowledge election of the Group II invention encompassing claims 5, 10, 11, 13, 14, 17, 18, 21-23 and 26.

Claims 1, 2 and 4 stand withdrawn as directed to non-elected subject matter, the Group I invention drawn to uses of the compounds. Applicants reserve the right for consideration of rejoinder of Claims 1, 2 and 4 when the Group II invention is allowed.

Claim 5 has been amended by deleting the proviso presented in a previous amendment. In addition, Claim 5 has been amended by deleting "4-cyanophenyl" as a value of Ar. Applicants assert the amendment raises no issue of new subject matter.

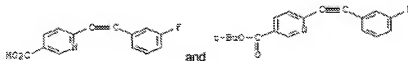
In view of the Examiners allowance of the elected species 5-(3-Chlorophenylethynyl)-nicotinonitrile, Applicants respectively request allowance of the claim corresponding to this species, Claim 26.

Claim Rejection: 35 U.S.C. 102(b)

The Examiner has rejected Claims 5, 10 and 11 under 35 USC 102(b) as being anticipated by two compounds disclosed in Hcaplus 130:124995. Applicants respectfully submit that compounds of the claimed invention are structurally distinct from the two compounds disclosed in Hcaplus 130:124995. As such, Claims 5, 10 and 11 are not anticipated by Hcaplus 130:124995.

It is understood Hcaplus 130:124995 is the chemical abstract for WO 99/02497 to Allgeier, Hans et. al. published January 21, 1999 for which a copy is provided herewith for the Examiner's convenience.

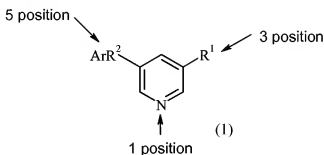
Hcaplus 130:124995 discloses the below compounds



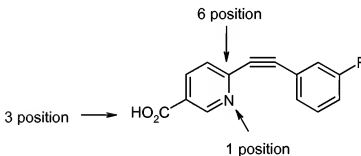
A species disclosed in the prior art anticipates a later claim to a genus containing that species. *Atlas Powder Co. v. Irecro Inc.*, 190 F.3d 1342, 1346, 51 U.S.P.Q.2d 1943 (Fed. Cir. 1999), "In chemical compounds, a single prior art species within the patent's claimed genus reads on the generic claim and anticipates," citing *In re Gosteli*, 872 F.2d 1008, 1010, 10 U.S.P.Q.2d 1614, 1616 (Fed. Cir. 1989). Thus, in order to anticipate the present invention, the two compounds disclosed in Hcaplus 130:124995 must fall within the genus of compounds of formula

1. Applicants respectfully assert the two compounds disclosed Hcaplus 130:124995 fall outside the scope of the present invention compounds because of the differences in location of the groups relative to each other, as well as the differences in location the groups relative to the nitrogen of the pyridine ring.

The present invention claims a compound of formula 1 which the required groups, R¹ and ArR², are attached to position 3 and position 5 of the pyridine ring, respectively. The positional relationship of these two groups is referred to meta substitution. Hcaplus 130:124995 discloses two compounds which the required groups are attached to position 3 and position 6 of the pyridine ring. Groups in a 3 and 6 positional relationship are in a para orientation (see below).



Compounds of the present invention



Compound of Hcaplus 130:124995

Applicants respectfully submit that compounds of the claimed invention are structurally distinct from the two compounds disclosed in the prior art because the compounds of formula 1 require groups which are attached to position 3 and position 5 of the pyridine ring (meta substitution) whereas the two compounds disclosed in Hcaplus 130:124995 require groups which are attached to position 3 and position 6 of the pyridine ring (para substitution). The two compounds disclosed Hcaplus 130:124995 clearly fall outside the scope of the present invention compounds because of these differences in location of the groups relative to each other, as well as

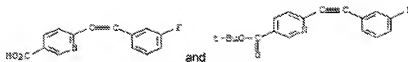
the differences in location the groups relative to the nitrogen of the pyridine ring. As such, Claims 5, 10 and 11 are not anticipated by Hcaplus 130:124995.

Claim Rejection: 35 U.S.C. 103(a)

The Examiner has rejected Claim 23 under 35 USC 103(a) as being obvious in view of two compounds disclosed in Hcaplus 130:124995. Applicants respectfully assert that Claim 23 is not obvious in view of this reference.

It is understood that Reference U refers to Hcaplus 130:124995 which is the chemical abstract for WO 99/02497 to Allgeier, Hans et. al. published January 21, 1999.

Hcaplus 130:124995 discloses the below compounds



Applicants respectfully assert the pharmaceutical compositions of Claim 23 are not obvious in view of the above prior art compounds because the compounds of present invention are not obvious in view of the same prior art compounds.

The differences in the prior art compounds and the compounds of the present invention were discussed previously under Claim Rejection: 35 U.S.C. 102(b).

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. MPEP §2143.

There is no suggestion or motivation to start with the two compounds disclosed in Hcaplus 130:124995 to arrive at compounds of formula 1 of the present invention. Applicants assert that there is no teaching or knowledge in the art to modify the two compounds disclosed in Hcaplus 130:124995 which require groups which are attached to position 3 and position 6 of the pyridine ring (para substitution) to arrive at the compounds of formula 1 which require groups which are attached to position 3 and position 5 of the pyridine ring (meta substitution). Any teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Applicants respectfully assert that Claim 23 is not obvious in view of the two compounds disclosed in Hcaplus 130:124995.

Claim Rejection: 35 U.S.C. 112, First Paragraph

The Examiner has rejected Claims 5, 10, 11, 13, 14, 17-18, 21, 22, 23 and 26 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The Examiner asserts the proviso at the end of Claim 5 which reads “when Ar is 4-cyanophenyl, R1 is a value other than CN” is new matter because it was not mentioned in the specification at the time of filing. Applicants have amended Claim 5 by deleting the proviso “when Ar is 4-cyanophenyl, R1 is a value other than CN”. This amendment should care for the rejection of Claims 5, 10, 11, 13, 14, 17-18, 21, 22, 23 and 26 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

In view of the amendments and remarks, the Examiner is requested to consider the application. Allowance of Claims 5, 10, 11, 13, 14, 17, 18, 21-23 and 26 is kindly solicited. Should it be helpful to expedite prosecution, the Examiner is encouraged to telephone.

Respectfully submitted,

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